

REMARKS

Favorable reconsideration of this application, in view of the following discussion, is respectfully requested.

Claims 1, 3-5, 7-11, 13 and 14 are pending in the present application. Claims 1 and 13 are amended, and new claim 14 is added by the present Response.

As an initial matter, Applicant thanks the Examiner for entry and consideration of the previous Response filed November 26, 2004.

**Rejection under 35 USC § 102**

Independent claim 13 was rejected under 35 USC § 102(e) as unpatentable over US Patent No 6,549,232 to TANIGUCHI et al (herein "TANIGUCHI"). This rejection is respectfully traversed. Applicant further expressly incorporates herein all arguments made in Applicant's previous official action responses.

Independent claim 13 recites, *inter alia*, that:

...when said photographing operation is set to said blank photographing mode and an image is photographed, said system controller stores image data in said buffer memory and does not automatically transfer said image data to a recording medium, ... when a recording medium is not installed in said electronic still camera, said system controller automatically sets said photographing operation to said blank photographing mode, and when a recording medium is installed but does not include a blank recording area sufficient to store image data, said system controller automatically sets said photographing operation to said blank photographing mode.

Support for these features is found in the specification at least in FIGS. 3A and 3B and at page 15, lines 1-23.

In a non-limiting example, FIGS. 3A through 3B show that when the PC card 43 is not attached, or when there is not sufficient blank recording area in the PC card 43, a photographing operation is automatically performed in accordance with the blank photographing mode (see the specification at page 15, line 24 through page 16, line 2). Accordingly, a test photographing operation can be repeatedly and promptly carried out without transferring image data from the buffer memory to the recording medium, for example (see the specification at page 16, lines 7-11).

In contrast, TANIGUCHI does not teach or suggest at least that "when said photographing operation is set to said blank photographing mode and an image is photographed, said system controller stores image data in said buffer memory and does not automatically transfer said image data to a recording medium," as recited in pending amended independent claim 13.

Moreover, amended independent claim 13 also recites, *inter alia*, "a volatile buffer memory for temporarily storing image data and which is configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation," support for which is found in the specification at least in FIG. 3B and at page 13, line 2 through page 14, line 8. Independent claim 1 is also amended to recite similar features.

In contrast, TANIGUCHI at col. 26, line 65 through col. 27, line 19 merely discusses issuing an erasing instruction to erase one of several frames of picture image

data in an "internal memory 40." However, TANIGUCHI does not teach a volatile buffer memory which can "overwrite the image data with subsequent image data obtained from a subsequent photographing operation," as recited in pending amended independent claims 1 and 13.

Accordingly, it is respectfully submitted amended independent claims 1 and 13, and each of the claims depending therefrom, patentably distinguish over TANIGUCHI, and it is respectfully requested this rejection be withdrawn.

**Rejection under 35 USC § 103**

Claims 1, 3-5 and 7-11 were rejected under 35 USC § 103(a) in view of TANIGUCHI and US Patent No 5,956,084 to MORONAGA et al (herein "MORONAGA"). This rejection is respectfully traversed.

As discussed above, amended independent claim 1 is believed to patentably distinguish over TANIGUCHI.

Furthermore, regarding MORONAGA, it is respectfully submitted MORONAGA also does not teach or suggest at least "a volatile buffer memory that temporarily stores image data obtained through a photographing optical system and is configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation," as recited in amended independent claim 1.

Rather, the "internal RAM 28" of MORONAGA cannot properly be compared to the volatile buffer memory recited in pending amended independent claim 1, because the "internal RAM 28" of MORONAGA is maintained indefinitely in order to effect long-

term storage (see MORONAGA at col. 9, lines 45-50 and col. 10, lines 20-31). Therefore, the "internal RAM 28" of MORONAGA is neither volatile nor temporary, and does not teach or suggest at least a volatile buffer memory.

Moreover, MORONAGA does not teach or suggest a volatile buffer memory which can "overwrite the image data with subsequent image data obtained from a subsequent photographing operation," as recited in amended independent claim 1. Accordingly, it is respectfully submitted amended independent claim 1 and each of the claims depending therefrom patentably distinguish over TANIGUCHI and MORONAGA, and it is respectfully requested this rejection also be withdrawn.

With respect to the Examiner's rejection of dependent claims 3-5 and 7-11, since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

#### **New claim 14**

In addition, new claim 14 is added to set forth the invention in a varying scope. New claim 14 recites, *inter alia*, "a volatile buffer memory configured to temporarily store first image data and to overwrite the first image data with subsequent image data obtained in a subsequent photographing operation," similarly to amended independent claims 1 and 13. New claim 14 also recites, *inter alia*, "a system controller configured to transfer the image data from the volatile buffer to a recording medium detected as

having sufficient blank space to store the image data, unless a blank recording mode is selected," support for which is found in the specification at least in FIGS. 3A and 3B and at page 15, line 1 through page 16, line 23.

New claim 14 is believed to be patentable at least for reasons similar as those discussed above regarding amended independent claims 1 and 13, and it is believed no new matter is added by new claim 14.

SUMMARY AND CONCLUSION

Entry and consideration of the present Response, reconsideration of the outstanding Office Action, and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate. Applicant has made a sincere effort to place the present invention in condition for allowance and believes that he has now done so.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the amended claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

P19601.A06

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is respectfully invited to contact the undersigned at the below-listed telephone number.

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July 12, 2005  
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